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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,633	03/11/2004	Timothy D. Killinger	29618/39225A	6669
4743 7590 10/12/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER MOHANDESI, JILA M	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/798,633

Applicant(s)

KILLINGER ET AL.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE 8/27/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Species I in the reply filed on June 12, 2006 is acknowledged.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/27/2007 has been entered.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Beck (US 3,724,920). Beck discloses a container for hanging file folders, comprising: surfaces for supporting hanging file folders (rails 16); and lips disposed on at least one end of the surfaces to prevent the file folders from sliding off of the surfaces, wherein the surfaces for supporting hanging file folders are capable of supporting the hanging file folders in a

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cascading fashion, and wherein the surfaces for supporting hanging file folders are on a wire insert. See Figure 1 embodiment.

5. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Foster et al. (US 5,815,903). Foster discloses a container for hanging file folders, comprising: surfaces for supporting hanging file folders (metal bars 14 and 14a); and lips disposed on at least one end of the surfaces to prevent the file folders from sliding off of the surfaces, wherein the surfaces for supporting hanging file folders are capable of supporting the hanging file folders in a cascading fashion, and wherein the surfaces for supporting hanging file folders are on a wire insert. See Figure 5 embodiment.

***Claim Rejections - 35 USC § 103***

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1- 4, 9-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platte, III (US 6,672,439). Platte discloses a portable container for holding office products and documents, the portable container comprising: a rigid structural portion (tote bag with front, back and bottom walls 12-16 being fairly rigid, see column 3, lines 11-14) capable of holding hanging folders in cascading configuration; and a cover portion made of pliable material (nylon fabric cover 52, see column 3, lines

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16-21 and column 4, lines 26-32) attached to the rigid structural portion; a shoulder strap (handles 64 and 66) that is secured to the rigid structural portion. See Figures 1-5 embodiments.

The portable container of Platte is capable of holding folders in a cascading configuration.

With respect to claims 9-11, Platte discloses a storage caddy (removable dividers) that has a lower portion and a pocket (50) for holding items such as pens. The storage caddy is supported by webs (elastic cable 28) extending inward from the rigid structural portion.

Platte discloses that the cover may be sewn or otherwise attached to the top edge of the back wall 14. In either event, a hinged connection is formed between the top edge of the back wall (14) and the cover (52) to allow it to be moved between the open and closed position. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cover portion removably attached, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

With respect to claims 2 and 3 whether the attachment means is rod member, flexible straps or any other art recognized equivalent is an obvious matter of choice, such as to require less manual dexterity to operate.

"[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way,

using the technique is obvious unless its actual application is beyond that person's skill."

*KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007).

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platte in view of Fox et al. (5,779,331). Platte as described above discloses all the limitations of the claims except to disclose the rigid structural portion including file folder hanging surfaces having variable heights so that file folders hanging from the rigid structural portion are arranged in a cascading manner. Fox discloses a portable container where a rigid structural portion includes file folder hanging surfaces having variable heights so that file folders hanging from the rigid structural portion are arranged in a cascading manner for better visibility and accessibility of files. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the rigid structural portion of Platte with file folder hanging surfaces having variable heights as taught by Fox so that file folders hanging from the rigid structural portion are arranged in a cascading manner for better visibility and accessibility of files.

9. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platte in view of Murray (3,281,193). Platte as described above discloses all the limitations of the claims except for a removable insert for providing hanging surfaces for hanging file folders of more than one size. Murray has been merely introduced to show that it is old and conventional to provide a removable insert for providing hanging surfaces for hanging file folders of more than one size. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of

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Murray to provide removable insert to the hanging surfaces of Platte for hanging file folders of more than one size.

With respect to claim 16 and the removable insert being made of metallic wire, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platte in view of Roegner (6,126,012). Platte as described above discloses all the limitations of the claims except for the storage caddy including a cardboard stiffener. Roegner has been merely introduced to show that it is old and conventional to provide stiffeners such as foam or cardboard a storage caddy to better maintain its shape. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of Roegner to provide cardboard stiffener to the storage caddy of Platte for better maintaining its shape.

11. Claims 1, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyr (US 6,206,567). Cyr discloses a portable container for holding office products and documents, the portable container comprising: a rigid structural portion (Container 10) capable of holding hanging folders in cascading configuration; and a cover portion made of pliable material (closure flap 2 made of nylon or cotton duek material) attached to the rigid structural portion; a shoulder strap (12) that is secured to the rigid structural portion; and the cover portion including an upper panel (top 34) that may be opened to provide access to file folders disposed within the container. See Figures 1-4

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embodiments. Inasmuch as it has been defined in the claims, the container portion (10) of the portable container of Cyr is rigid regardless of the material that it is made of since it is capable of supporting itself in an upright position as shown in Figures 1-4 embodiment.

With respect to the cover being removable, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cover portion removably attached, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

The portable container of Cyr is capable of holding folders in a cascading configuration.

**12.** Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strong (US 5,873,730) Strong discloses a portable container for holding office products and documents, the portable container comprising: a rigid structural portion (bag body 12) capable of holding hanging folders in cascading configuration; and a cover portion (closure flap 32) attached to the rigid structural portion; a shoulder strap (44) that is secured to the cover portion which passes through at least one aperture in the cover portion. See Figures 1-4 embodiments.

Inasmuch as it has been defined in the claims, the body bag (12) of the portable container of Strong is rigid regardless of the material that it is made of since it is capable of supporting itself in an upright position as shown in Figures 1-4 embodiment.



With respect to the cover being removable, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cover portion removably attached, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

The portable container of Strong is capable of holding folders in a cascading configuration.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Beck or Foster in view of Murray (3,281,193). Each of Beck or Foster as described above discloses all the limitations of the claims except for a removable insert for providing hanging surfaces for hanging file folders of more than one size. Murray has been merely introduced to show that it is old and conventional to provide a removable insert for providing hanging surfaces for hanging file folders of more than one size. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of Murray to provide removable insert to the hanging surfaces of either one of Beck or Foster for hanging file folders of more than one size.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Beck or Foster. With respect to claim 18 if there is any doubt that the rails of Beck and/or Foster are made of metallic wire, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rails of metallic wire, since it has been held to be within the general skill of a worker in the art to select a

known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

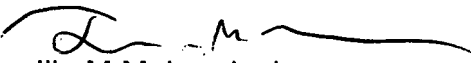
15. Applicant's arguments with respect to claims 1-18 and 20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jila M Mohandesi

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Primary Examiner  
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JMM  
October 5, 2007